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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,978	03/10/2004	Ken Takano	YMOR:172A	2207
27890	7590	07/03/2006	EXAMINER	
STEPTOE & JOHNSON LLP 1330 CONNECTICUT AVENUE, N.W. WASHINGTON, DC 20036			ARBES, CARL J	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

C

Office Action Summary	Application No.	Applicant(s)	
	10/795,978	TAKANO ET AL.	
	Examiner	Art Unit	
	C. J. Arbes	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/654,043.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>herein</u> . | 6) <input type="checkbox"/> Other: _____ |

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Applicants' Remarks with respect to the Office's Restriction which was mailed on or about 30 November 2005 and re-mailed 30 May 2006 have been carefully reviewed but are not held to overcome the Office's holding that there are 2 separate and distinct inventions in this Applications. Applicants remark that the subject matter of the 2 inventions sufficiently related so that a search of the subject matter of one of the inventions would necessarily encompass the search of the other of the inventions and therefore no serious burden would result on the Office. The Office's position is that Applicants have not provided an adequate foundation for why there would not be a serious burden on the Office and also why the one invention would necessarily encompass the subject matter of the other invention. Moreover Applicants have not demonstrated that the Office has erred in holding that the Restriction was in error. Therefore the Office holds that the Restriction was and currently is Final. Applicants are therefore required to cancel all non-elected claims or take other appropriate action.

An Office action on the merits of Claims 1-5 and 11-15 follows.

N.B. Inasmuch as the art which is being applied below has one priority date of 02 September 1999 and the instant application has a priority date of 03 September 1999 it is required that Applicants submit a verified translation of their priority document in this Application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 1-5 and 11-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is held that Applicants' "control section" (in at least their claims 1-4 and 11 is the essential or substantial portion of this alleged invention. Yet in the 22 pages of specification the Examiner can find a relatively minor portion of the specification which expressly speaks to the essentials or substance of this fundamental section. For example Applicants disclose that element 7 (Cf. page 9) is the control section and yet in Figure 1 Applicants depict this section as a black box. On page 10 of the instant specification Applicants disclose what the control section does but do not describe what goes into the control section or how it is made e.g. what components make up the control section. On page 15 of the specification Applicants disclose that control apparatus (130) first moves the board operating apparatus to a place nearest to Again Applicants do not spell out what the that which the so-called control apparatus is comprised. Exactly the same thing is true whenever examines page 16 of the specification. There is not sufficient details to allow a PHOSITA to know what the control section is comprised and hence he cannot make or use this section without undue experimentation. Other than these few and terse disclosures of the "control section" there is nothing else within the 22 pages of specification which clearly shows one how to make and use the control section. Hence it is held that Applicants' specification is non-enabling.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-5 and 11-15, assuming that the disclosure is enabling, are further rejected under 35 U.S.C. 103(a) as being unpatentable over Yazawa et al (Pat No. 6,948,232 B1); hereinafter Yazawa et al.

Yazawa et al teach a component recognizing apparatus which recognizes components by their heights. The components are held in a plurality of nozzles (724-733) which are a part of the head unit (700). The nozzles are recognized by and is managed by a drive unit (704-713). In Column 7 Yazawa et al teach as the 17th aspect of the invention (in the prior art) that there is a ... a 2nd control unit to drive the drive unit in response to a positioning operation starting instruction of the selected component holding member. According to the 18th aspect (also Col 7) of the invention (of Yazawa et al's) there is a component recognizing apparatus as defined in the 17th aspect of their invention, wherein a plurality of sets of parameters of target positions are provided, and thereby the second control unit is adapted to execute continuous positioning operations with provision of a plurality of timings. According to the 19th aspect of the prior art invention there is provided a component recognizing system wherein with a plurality of positioning operation ending positions corresponding to the plurality of operation starting positions, the second control unit is adapted to judge whether individual positioning operations during continuous positioning operations

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which were started at the plurality of positioning operation starting positions have reached respective positioning operation ending positions or not. Given these elements or teachings from the prior art it would have been obvious to provide a control section which would store information relating to the components and to transmit that information to the nozzles so that the nozzles would mount the components according to ascending order of height. The control section which is claimed by Applicants is construed to be the "control unit" in the Yazawa et al prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. J. Arbes whose telephone number is 571-272-4563. The examiner can normally be reached on M, T, R and F from 8 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, P. Vo, can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CARL J. ARBES
PRIMARY EXAMINER